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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 10/656,124 | 09/08/2003 | Vito Lambertini | Q76661 | 8655 |
| 23373 | 7590 | 07/10/2006 | EXAMINER | |
| SUGHRUE MION, PLLC 2100 PENNSYLVANIA AVENUE, N.W. SUITE 800 WASHINGTON, DC 20037 | | | PADGETT, MARIANNE L | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 1762 | |

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | | |
|---|---------------------------------|-----------------------------------|--|
| Advisory Action Before the Filing of an Appeal Brief | Application No. 10/656,124 | Applicant(s) LAMBERTINI ET AL. | |
| | Examiner Marianne L. Padgett | Art Unit 1762 | |

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 22 June 2006 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☒ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because
(a) ☒ They raise new issues that would require further consideration and/or search (see NOTE below);
(b) ☐ They raise the issue of new matter (see NOTE below);
(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
(d) ☒ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).
5. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.
The status of the claim(s) is (or will be) as follows:
Claim(s) allowed: _____
Claim(s) objected to: _____
Claim(s) rejected: 1-15.
Claim(s) withdrawn from consideration: 16-21.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).
9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing of good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).
10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☒ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____
13. ☐ Other: _____



MARIANNE PADGETT
PRIMARY EXAMINER

Continuation of 3. NOTE:

The amendment to claim 1, step (c) changes the possible scope of this limitation (thus is a new issue), but does not necessarily remove the section 3 rejection over 112, first paragraph, as its scope is now ambiguous, not clearly or necessarily supported by page 6 of the specification., since "control of state of polymerization based on variation of the index of refraction of the layer" is ambiguous in that how the control of polymerization is based on variation of the index of refraction is not clear & could be employing an already present variation in the refractive index to effect the control or could be through a technique as described in claims 7 or new claim 22, etc (thus creating a different new matter/scope issue).

New claims 22 & 23 present new claims without canceling any previously examined claims. In claim 23 the changing of the mixture from a liquid state to a gelatinous state via "pre-polymerization" is a new issue, as it is specified not to be polymerization or to be before the polymerization, and is unlike previously presented claim 8 which uses UV radiation to cause such a transformation. New claim 22 appears to clarify the issues set forth in section 4 of the 2/22/2006 rejection, but thus by doing so presents a claim that requires further search and consideration for the now clarified intent/claim. New claim 23 which lacks any control based on or by means of refractive index, or the like, requires renewed consideration of previously applied art, etc.

Continuation of 5.

Applicant's reply has overcome the following rejection(s): Applicants' amendment would correct the objection in section 2 of the 2/22/2006 rejection & the references supplied appear to provide adequate definitions for the terms rejected under 112, second paragraph in section 4, although with respect to the Odenback reference "Magnetoviscous Affects in Ferrofluids", it is noted that the highlighted lines are totally illegible, as the highlighting blocks them out in the scanned version available to the examiner. From this reference it appears that ferrofluids should be defined as any fluid material whose viscous properties are affected by the action of a magnetic field. It is noted that use of the Foreword in the "Handbook of Nanostructured Materials..." used to provide a definition/scope for nanoparticles, would provide dimensional range of 1-100 nm, not up to 100 nm.

Continuation of 11. does NOT place the application in condition for allowance because:

The new issues require further consideration. Applicant may also wish to note in independent claim 1 "photopolymerizable mixture..." describes a capability or a way in which the mixture may be polymerized, but does not necessitate that when polymerization occurs that it was done by a photo-technique or require any particular wavelength for range to be employed, thus a limitation merely directed to "exposure of the layer to UV radiation", which does not say what that radiation does to the layer need not have caused any polymerization to occur, especially as the UV exposure step & the polymerization step may be totally different steps.

